

Attorney Docket No. 0756-2401

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Akira MASE

Serial No. 09/995,866

Filed: November 26, 2001

For: CONDUCTIVE PATTERN

PRODUCING METHOD AND ITS

APPLICATIONS

) Group Art Unit: 2871

) Examiner: H. Nguyen

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Adelle M. Stanger

RESPONSE

Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Official Action mailed February 11, 2004, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to June 11, 2004. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statement filed on November 26, 2001.

Claims 2-12 are pending in the present application, of which claims 2, 4, 7 and 10 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 1 of the Official Action rejects claims 2 and 3 as obvious based on the combination of U.S. Patent No. 4,385,976 to Schuster-Wolden et al. and U.S. Patent No. 4,462,883 to Hart. Paragraph 2 of the Official Action rejects claims 4-9 as obvious based on the combination of Schuster-Wolden, Hart and U.S. Patent No. 4,680,226 to Takeda. The Applicants respectfully traverse the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Regarding whether Schuster-Wolden and Hart describe analogous art, the present Official Action appears to be exactly the same as the previous rejection. In the *Amendment* filed November 4, 2003, the Applicant argued that Hart is directed to an entirely different field from the present invention and Schuster-Wolden. In response to this argument, the Examiner asserts that the "display device" is considered as a preamble. Specifically, the Official Action appears to ignore the recitation of a display device in the preamble. MPEP § 2111.02 discusses the weight of the preamble of a claim as follows:

[A] claim preamble has the import that the claim as a whole suggests for it." Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if

in the balance of the claim.” Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (A preamble reciting “An abrasive article” was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated “it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an ‘abrasive article.’” Therefore, the preamble served to further define the structure of the article produced.).

Similarly, here, the recitation of “a display device” gives life, meaning and vitality to the claim as a whole. The claims of the present invention are specifically concerned with a display device comprising a glass substrate; a lead formed over the glass substrate, the lead comprising a first layer comprising silver or a first conductive layer and a second layer comprising indium tin oxide formed on the first layer; an IC chip provided over the glass substrate and electrically connected to the lead wherein a pad of the IC chip is electrically connected to the second layer of the lead. Further, the Applicant respectfully submits that the inclusion of a display device in the preamble is essential to point out the invention defined by the claims. Accordingly, the preamble of the claims of the present invention cannot be properly dismissed when evaluating the scope of the claims.

Even if “display device” in the preamble does not give life, meaning and vitality to the claim as a whole, the Examiner still fails to address the issue that Hart is directed to an entirely different field of endeavor from the present invention and Schuster-Wolden, and therefore one of skill in the art would not have been motivated to combine the references as asserted in the Official Action. Specifically, Hart is directed to low emissivity coatings, particularly coatings for window glass (col. 2, lines 5-9 and 51-54), which are entirely irrelevant to a lead to be electrically connected to an IC. Consequently, Hart is not in the field of the Applicant’s endeavor, is not reasonably pertinent to the particular problem with which the inventor is concerned, and would not have logically commended itself to an inventor’s attention in considering the problem

(see MPEP § 2141.01(a)). Therefore, the Applicant respectfully submits that the Official Action has not provided a proper suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Schuster-Wolden and Hart or to combine reference teachings to achieve the claimed invention.

Despite the above arguments, the Applicant respectfully submits that the Examiner fails to establish a *prima facie* case of obviousness. The Official Action asserts that the combination is “for anti-reflecting” (page 3, Paper No. 0104). The Applicants respectfully disagree and traverse the above assertion in the Official Action. Although Hart appears to describe an “anti-reflection metal oxide coating” for window glass, the prior art lacks any teaching or suggestion that teaches the desirability of the use of such a window glass “anti-reflecting” coating in a connection between a lead and an IC chip of a display device. Schuster-Wolden and Hart, either alone or in combination, do not teach or suggest why one of ordinary skill in the art would have been motivated to add to the device of Schuster-Wolden a lead comprising a first layer comprising silver or a first conductive layer and a second layer comprising indium tin oxide formed on the first layer; and then further modify the alleged combination such that an IC chip is provided over a glass substrate and electrically connected to the lead where a pad of the IC chip is electrically connected to the second layer of the lead, as claimed in the independent claims of the present invention.

Takeda does not cure the deficiencies in the motivation to combine Schuster-Wolden and Hart. The Official Action relies on Takeda to allegedly teach the features of an adhesive (page 4, *Id.*). Takeda does not show that Hart is in the field of the Applicant’s endeavor, is reasonably pertinent to the particular problem with which the inventor is concerned, or would have logically commended itself to an inventor’s attention in considering the problem.

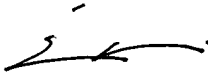
Further, the Official Action asserts that “the specification does not disclose the unexpected result or motivation (why it is important) of a lead comprising a second

indium-tin-oxide layer formed on the first silver layer" (page 4, Paper No. 0104). The Applicant respectfully submits that the Examiner has improperly reversed the burden of proving a *prima facie* case of obviousness. MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully submitted that the Official Action has failed to carry this burden. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be used together, it is submitted that the Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the present invention.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



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2871
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TRANSMITTAL FORM

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	Group Art Unit	2871	
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ENCLOSURES (check all that apply)

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